

PATENT  
Atty. Docket No. STK-001CP2DVFWC

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

*FJ23*

APPLICANT(S): Oppermann et al.  
 SERIAL NO.: 07/621,988 GROUP NO.: 1503  
 FILED: Dec. 4, 1990 EXAMINER: NUTTER, N.  
 TITLE: OSTEOGENIC PROTEINS

## CERTIFICATE OF EXPRESS MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail, postage prepaid, Mailing Label No. GB736121023, in an envelope addressed to the: Honorable Commissioner of Patents and Trademarks, Washington, D.C. on December 22, 1992.

*Robin E. Bolduc*  
Robin E. Bolduc

TRANSMITTAL LETTER FOR PETITION TO WITHDRAW  
APPLICATION UNDER 37 CFR 1.313(b)

RECEIVED

Attention: Petitions Office

JAN 14 1993

BOX DAC  
The Honorable Commissioner  
of Patents & Trademarks  
Washington, D.C. 20231

4/10/93  
OFFICE OF PETITIONS  
A/C PATENTS

Sir:

Applicants, with the consent of the assignee of record, Stryker Corporation (by virtue of the Assignment recorded September 3, 1991, reel 5863, frames 0091-0094) hereby petition that the above-referenced application, for which an issue fee was paid on September 1, 1992, be withdrawn from issue pursuant to the provision of 37 C.F.R. 1.313(b)(5) to permit consideration of the enclosed reference, which is being submitted as part of an Information Disclosure Statement under 37 C.F.R. 1.97(b) in a

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Applicant:  
U.S.S.N.:  
Filed:  
Page 2

file wrapper continuation of the above-referenced application. The above-referenced application will be abandoned in favor of the file wrapper continuation. A Petition and check for \$130.00 is enclosed as payment of the fee associated with this Petition, as required under 37 C.F.R. 1.17(i). Kindly charge any deficiency in the fee payment, or credit any overpayment, to Deposit Account No. 20-0531. A copy of the Petition is enclosed for this purpose.

In the event the above-referenced application already has been accorded a patent number and issue date, Applicants hereby also request that the Commissioner waive the requirements of 37 C.F.R. 1.313(b) and grant the Petition to Withdraw.

Applicants have good and sufficient reason for requesting withdrawal of the application from issue for the following reasons. Prior to the grant of a patent for the instant application, Applicants wish to bring to the Patent Office's attention, and have the Patent Office consider, U.S. Patent No. 5,013,649 (the "'649" patent), issued to Wang et al. on May 7, 1991, which is available as a 102(e) reference against this application as of April 8, 1988, and which may be pertinent to patentability of the instant application. Applicants inadvertently neglected to submit this patent to the Patent Office during prosecution of the instant application. The failure was an inadvertent oversight that did not occur with deceptive intent. Moreover, until now, Applicants did not fully appreciate that the '649 patent contained material beyond that disclosed in WO88/00205, and in Wozney et al. (1988) Science 242: 1528-1534, both already of record in the Patent Office.

Accordingly, together with this Petition, Applicants are filing a continuing application under 37 C.F.R. 1.62, filed with the U.S. Patent Office via the Express Mail procedure, as well as a Preliminary Amendment and Information Disclosure Statement

JJD

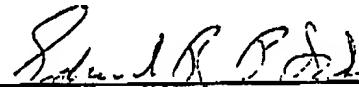
Applicant:  
U.S.P.N.:  
Filed:  
Page 3

citing the '649 patent, in accordance with 37 C.F.R. §1.97.  
Details of the disclosure of the '649 patent and how the claims  
of the instant application are patentably distinct therefrom are  
described in the Information Disclosure Statement.

The Information Disclosure Statement also makes of record  
U.S. Patent No. 5,166,058, filed July 11, 1989 and issued to Wang  
et al. on November 24, 1992. While the '058 patent is not prior  
art to the instant application, Applicants bring it to the  
Examiner's attention in an effort to provide complete disclosure.

Applicants respectfully request that their petition be  
granted forthwith.

Respectfully submitted,

  
Edmund R. Pitcher  
Attorney for Applicants  
Reg. No. 27,829

Date: December 22, 1992

TESTA, HURWITZ & THIBEAULT  
Exchange Place, 53 State Street  
Boston, MA 02109  
(617) 248-7000

299RDK7557/2.AS2

BB

FORM 9-33

Docket No.: STK-001CP2DVFWC

## PATENT

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Oppermann et al.  
 Serial No.: 0 7 621,988  
 Filed: 12/4/90  
 For: OSTEOGENIC PROTEINS

Group No: 1503  
 Examiner: Nutter, N.  
 Date of mailing "Notice of Allowance and Base Issue Fee Due" 6/5/92  
 Batch No. D38

Box DAC  
 Commissioner of Patents and Trademarks  
 Washington, D.C. 20231

NOTE: Petition to withdraw patent applications from issue (37 CFR 1.313, MPEP § 1308) are decided by the Deputy Assistant Commissioner of Patents, MPEP § 1002(b). Letters requesting the application be withdrawn from issue for purposes of interference with a patent (see MPEP § 1101.02(l)) require the approval of the Group Director, MPEP, § 1003.

## PETITION FOR WITHDRAWAL FROM ISSUE (37 CFR 1.313)

## PETITION

1. Applicant hereby petitions for the withdrawal of this application from issue.

## PATENT ISSUE FEE

2. The issue fee for this case

(complete (a) or (b))

(a)  has NOT been paid, but is due for payment on \_\_\_\_\_

(b)  has been paid on 9/1/92

(complete the following, if known)

this application is scheduled to

issue on 1/26/93

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I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail" from the Patent Office to Addressee service under the date indicated above and is in the name of the Commissioner of Patents and Trademarks, Washington, D.C. 20231.

Robin E. Bolduc

(Typed or printed name of person mailing paper or fee)

Robin E. Bolduc

(Petition for Withdrawal from Issue (37 CFR 1.313) [9-33]—page 1 of 2)

JJB

as patent

**NOTE:** "While the specific time period varies, an allowed application generally receives a patent number and issue date within two weeks after the issue fee is received in the Patent and Trademark Office." MPEP § 1308.

#### REASON(S) FOR WITHDRAWAL REQUEST

**NOTE:** "When the issue fee has been paid, and the patent to be issued has received its issue date and patent number, the application will not be withdrawn from issue for any reason except (1) mistake on the part of Office, (2) a violation of Section 1.56 or Illegality in the application, (3) unpatentability of one or more claims, or (4) for interference." 37 CFR 1.313(b).

3. The reason for the request for withdrawal from issue is:

(check applicable item(s) below)

- (a)  there has been a mistake on the part of the Office.
- (b)  there has been a violation of Section 1.56 or Illegality in the application.
- (c)  one or more of the claims are unpatentable.
- (d)  for purposes of declaring an interference.
- (e)  other. To permit consideration of an Information Disclosure Statement under 37 C.F.R. §1.97 in a continuing application as attached 3 sheet(s). Further details as to the reason(s) for this withdrawal requests are set forth on the attached 3 sheet(s). provided under 37 C.F.R. 1.313(b)(5).

#### PETITION FEES

**NOTE:** The fee need only be paid if the reason for withdrawal is not the fault of the Office. 37 CFR 1.313(a).

4. The petition fee is paid as follows:

- Enclosed is a check in the sum of \$130.00.
- Charge Account \_\_\_\_\_ the sum of \$130.00.  
A duplicate of this petition is attached.

x Please charge any additional fees associated  
with this Petition to Deposit Account No. 20-0531.

Reg. No. 27,829

Tel. No.: (617) 248-7000

Edmund R. Pitcher

Type or print name of attorney  
Testa, Hurwitz & Thibeault

P.O. Address  
Exchange Place/53 State Street

Boston, MA 02109

Plus 3 Added Pages

(Petition for Withdrawal from Issue (37 CFR 1.313) [9-33]—page 2 of 2)

*JB4*

RORM 9-33

Docket No.: STK-001CP2DVFWC

## PATENT

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Oppermann et al.

Serial No.: 0 7 621,988

Group No: 1503

Filed: 12/4/90

Examiner: Nutter, N.

For: OSTEOGENIC PROTEINS

Date of mailing "Notice of Allowance and Base Issue Fee"

Due: 6/5/92

Batch No.: D38

Box DAC

Commissioner of Patents and Trademarks

Washington, D.C. 20231

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## PETITION FOR WITHDRAWAL FROM ISSUE (37 CFR 1.313)

## PETITION

1. Applicant hereby petitions for the withdrawal of this application from issue.

## PATENT ISSUE FEE

2. The issue fee for this case

(complete (a) or (b))

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<b>FROM:</b>		
Robin D. Kelley Testa, Hurwitz & Thibeault Exchange Place 53 State Street Boston, MA 02109 STK-001CP2DVFWC (7557/2)		
<p><b>Waiver of Signature and Indemnity (Domestic Only)</b></p> <p>I, Robin D. Kelley, do hereby waive my signature on the instrument of transmission of this document, and I acknowledge that the signature of the addressee will suffice to verify the contents of this document. I further acknowledge that the signature of the addressee will not constitute an admission that the signature of the addressee is valid or that the addressee has authority to bind me in any way by such signature. I also acknowledge that the signature of the addressee will not constitute an admission that the addressee is entitled to rely on the contents of this document.</p> <p><b>CUSTOMER RECEIPT</b></p> <p><b>TO:</b> The Honorable Commissioner of Patents &amp; Trademarks Washington, D.C. 20231 X FW</p> <p>Telephone Number: X</p> <p>Thank You For Using Express Mail Service</p>		

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01/14/93 14:30  
01/14/93 14:31

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4001  
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The "RECEIVED" stamp of the Patent Office imprinted hereon  
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STK-001CP2DVFWC

Petition to Withdraw & Transmittal Letter with  
check for \$130, File Wrapper Continuation Application  
with check in the amount of \$940.00, Preliminary  
Amendment, IDS, PTO Form 1449 copies of cited references.

Name of Applicant: Oppermann et al.

Int'l. or Serial Number: FWC of 621,988 filed 12/3/90

Atty: ERPITCHER

Date: Express Mail 12/22/92 Label  
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236

TESTA, HURWITZ &amp; THIBEAULT 53 STATE ST., BOSTON, MA 02109

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TESTA, HURWITZ & THIBEAULT

ATTORNEYS AT LAW

OFFICE (617) 248-7000

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53 STATE STREET

BOSTON, MASSACHUSETTS 02109-2809

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TELECOPY COVER SHEET

Equipment Operator Contact Number: 617-248-7462. Please call if you do not receive all the pages.

TO: Name Daryl Smith  
Company OP TO - Petition Branch  
Address Washington D.C. 20231  
Telephone 703-305-9282  
Fax 703-305-8825

FROM: Sender Name E.R. Pitcher  
Number of Pages INCLUDING This Cover Sheet 9  
Client 7557/2  
(please fill in)

Comments Enclosed are copies of 1) Postcard 2) Express  
mail receipt 3) petition to withdraw from  
issue 4) check stub for \$130 petition fee 5)  
transmittal letter, all mailed on Dec. 22, 1992.  
Also mailed on that date but not enclosed was  
an FWC application and preliminary memorandum  
and T.D.S. Reason for withdrawal is to permit  
consideration of art in a continuing application

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